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MAY 25 2007

OFFICE OF PETITIONS

In re Application of :
Rosen et al. :
Application No. 09/937,192 : Decision on Petition for
International Filing Date: April 7, 2000 : Patent Term Extension
For: METHODS AND COMPOSITIONS FOR :
DEGRADATION AND/OR INHIBITION OF :
HER-FAMILY TYROSINE KINASES :

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition To The Director Under Rule 1.181," received on January 10, 2007.. The petition is being treated as a petition for corrected patent term extension under 37 CFR 1.701 and 37 CFR 1.181. See 35 U.S.C. § 154(b)¹ and 37 CFR § 1.701.

The petition under 37 CFR 1.181 is dismissed.

Petitioner notes that the Notice of Allowance mailed on December 7, 2006, for the above-identified application did not contain an indication of patent term extension under 35 U.S.C. § 154(b).

Petitioner contends that the instant application is entitled to 1054 days, 602 days or at the very least 338 days of patent term extension as compensation for the delays due prosecution of the application. Petitioner contends that since the Examiner was reversed on the § 112 first and second paragraph rejections that there was a final decision in favor of applicant.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

¹ 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000.

The above-identified application was filed on April 7, 2000. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was a successful appellate review, interference or a secrecy order delays as set forth in the statute.

Petitioner's argument that patent term extension should be awarded to the above-identified application because there was a final decision in favor of the Applicant is not persuasive. While the examiner was reversed on the § 112 rejections, the Examiner was affirmed on the provisional obvious double patenting rejections for all the claims. Since the Examiner has not been reversed on at least one claim for all the grounds, there is not a final decision in favor of applicants. As noted on page 8 of the "Decision on Appeal" mailed on August 28, 2006, the Examiner was "Affirmed."

The delay in the allowance and issuance is regrettable, but the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154(b).

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). The required \$200 fee for a petition under 37 CFR 1.705(b) has been paid. Any request for reconsideration of this decision must be submitted as a petition under either 37 CFR 1.182 or 37 CFR 1.183 with the required fee.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted or mailed by the Office, as it unnecessarily increases the cost to the Office. *See* 37 CFR 1.4(b).

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



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